

The test of whether a claim is subject to a 35 U.S.C. §101 double patenting rejection is enunciated in *In re Vogel*, 57 CCPA 920, 422 F.2d 438, 164 USPQ 619 (1970), where the court said:

"By 'same invention' we mean identical subject matter. Thus the invention defined by a claim reciting 'halogen' is not the same as that defined by a claim reciting 'chlorine,' because the former is broader than the latter."

The court also said:

"A good test, and probably the only objective test, for 'same invention,' is whether one of the claims could be literally infringed without literally infringing the other."

In applying this test to pending claims 1-26 of this application vs. claims 1-26 of the 10/360,294 ('294) application, all claims of the '294 application require a thermoplastic polymer in addition to a rubber. The claims herein recite a rubber without also requiring a thermoplastic polymer. Therefore, situations exist wherein claims 1-26 of this application could be literally infringed without literally infringing claims 1-26 of the '294 application. This possibility exists because without a thermoplastic polymer, all claims herein would be infringed, but no claim of the '294 application would be infringed, thereby passing the test of different inventions set forth by the CCPA in *In re Vogel*.

Further, in *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969) the court stated:

"The analysis of whether one invention has been twice claimed requires a factual inquiry into whether the claims of the application are directed to the same subject matter, or invention, as the claims of the patent. If there be any substantive difference, and not merely a difference in language, then the inventions are not the same no matter how small or how obvious those differences may be."

It is submitted that claims 1-26 in the present application are substantively different, as opposed to a mere difference in language. Claims 1-26 of the '294 application are clearly narrower in scope than claims 1-26 of this application.

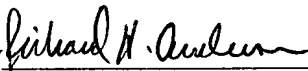
Application No.: 10/616,658

Docket No.: 27702/10046A

Enclosed is a proper Terminal Disclaimer to obviate any obviousness double patenting rejection that might be given after withdrawal of the §101 double patenting rejection.

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Respectfully submitted,

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